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10/822,070

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Joseph Dube

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EXAMINER

LUONG, VINH

ART UNIT

PAPER NUMBER

3682

MAIL DATE

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08/06/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/822,070

Applicant(s)

DUBE ET AL.

Examiner

Vinh T. Luong

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,8 and 17-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7 and 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/9/04 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



Vinh T. Luong
Primary Examiner

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☒ Other: Attachments 1 and 2.

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1. Applicant's election of Group I and the species of FIGS. 1A-1C, 2A-2C, and 6 in the reply filed on May 24, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse. MPEP § 818.03(a).

2. Claims 3, 4, 8, and 17-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and/or species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 21, 2007.

3. The drawings are objected to because:

(a) Each part of the invention, such as, the steering angle member in Claims 11-16 and paragraph [0054] of the specification should be designated by a referential character; and

(b) The drawings are not in compliance with 37 CFR 1.84. See Form PTO-948 attached.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be

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notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features, such as, (a) the selectable positions in Claims 1 and 7; (b) the angle of the steering stem and the change of the angle of the steering stem in Claim 10; and (c) the steering angle member/inset which is flush with or within said steering stem bore below the outer surface of the frame member in Claim 14 must be shown or the features canceled from the claims. *No new matter should be entered.*

Applicant separately shows each part of the invention, such as, the frame member 10, the handlebar support member 40, etc. None of Applicant's figures show the essential cooperative relationship of the claimed elements, i.e., the combination of various parts set forth in the functional statements in the claims. Further, note that the moved positions such as the selectable positions or the change of the angle of the steering stem may be shown by a broken line superimposed upon a suitable view if this can be done without crowding; otherwise, a separate view must be used for this purpose. See 37 CFR 1.84(h)(4).

5. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

6. The disclosure is objected to because of the following informalities:

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(a) The specification is inconsistent with the drawings or *vice versa*. For example, sheet 2 of drawings show FIGS. 6, 7A, and 7B, however, the Brief Description of the Drawing does not describe FIGS. 6, 7A, and 7B; and

(b) Each part of the invention, such as, the steering angle member in Claims 11-16 and paragraph [0054] of the specification should be designated by a referential character.

Appropriate correction is required.

7. Claims 1, 2, 5-7, and 9-16 are objected to because of the following informalities: the claims have typographical or grammatical error. For example, the recitation “comprising,” in line 2 of Claims 1, 7, and 10 should have been changed to “comprising:” and “to receive fork member” in line 4 of Claim 7 should have been changed to “to receive said fork member.”

Appropriate correction is required.

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 10-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 10 recites “one or more means to selectively change said angle of said steering stem.” In addition, Claim 11 recites “one or more of said means to selectively change said angle of said steering stem comprises, a steering angle member, having an offset bore through said

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inset member adapted to receive said steering stem, that is adapted to be removably fixed in said steering stem bore.”

On the one hand, FIGS. 1A-1C show that the inset member 20 surrounds the stem bore 16, meanwhile, the inset 20 is fixedly attached to the frame 22. Moreover, the drawings show that the bore 21 is concentric with the stem bore 16 as best seen in FIG. 1B. Since the position of the inset 20 is fixed, consequently, the position of the bores 21 and 16 are fixed therewith. Moreover, the drawings do not show the steering stem. Since the positions of the inset 20 and bores 21 and 16 are fixed or unchanged as illustrated in FIGS. 1A-1C, it is unclear as to how the inset 20 changes the angle of the un-illustrated steering stem as claimed.

On the other hand, Applicant’s description “[t]he user may adjust the angle by repositioning inset member 20 into bore 16” in paragraph [0054] is inconsistent with the drawings, e.g., FIGS. 1A-1C. These figures show that the inset 20 is larger than the bore 16 and the bore 16 is located within the inset 20, therefore, one may not reposition the inset 20 into the bore 16 as described.

Applicant’s disclosure is inadequate because the specification does not *reasonably* convey as to how the inset 20 can change the angle of the steering stem to one skilled in the relevant art at the time the application was filed. See means-plus-function language in *In re Donaldson Co. Inc.*, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994); *In re Dossel*, 42 USPQ2d 1881, 1884 (Fed. Cir. 1997); and *Biomedino LLC v. Waters Technologies Corp.*, 83 USPQ2d 1118 (Fed. Cir. June 18, 2007).

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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11. Claims 11-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "said inset member" in line 3. There is insufficient antecedent basis for this limitation in the claim.

It is unclear whether a confusing variety of terms, such as, "means to selectively change said angle of said steering stem," "a steering angle member" and "said inset member" in Claim 11 refer to the same or different things. See MPEP 608.01(o) and double inclusion in MPEP 2173.05(o). Applicant is respectfully urged to identify each claimed element with reference to the drawings.

The meaning of the term "offset" in Claim 11 is unclear since there is no referential datum. It is unclear the bore 21 is offset relative to what structure.

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1, 2, 5-7, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Henricksen (US Patent No. 7,018,126 B2 filed on March 29, 2004 which is a continuation of US Patent No. 6,712,541 filed on December 5, 2001).

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Regarding Claim 1, Henricksen teaches a triple clamp adapted for use with a vehicle having a steering stem (not shown), one or more fork members (not shown), and one or more handlebars 10 (FIG. 3), comprising:

a frame member 26 (see Attachment 1 hereinafter "Att. 1") having a perimeter that comprises a front edge (Att. 1) and a back edge (Att. 1) and having a centerline (Att. 1) between said front and said back edges (Att. 1), comprising,

one or more fork member bores 32, 33 adapted to receive said fork member,
one or more steering stem bores 27 adapted to receive said steering stem;
one or more handlebar support members 11-13 adapted to support said handlebar 10; and
one or more means 22-25 to selectively maintain said handlebar support member 11-13 in one or more selectable positions;

wherein, said frame member 26 has one or more frame engaging parts 14-21 that are adapted to engage, at said selectable positions, one or more handlebar support engaging parts 43-46 provided on said handlebar support member 11-13, and wherein at least two of said selectable positions are inherently between said front edge and said centerline, and at least two of said selectable positions are between said back edge and said centerline.

Claim 1 and other claims below are anticipated by Henricksen because Henricksen teaches each positively claimed element in the claims and its functional statement. Note that Henricksen's frame engaging parts 14-21 are rubber or polymer cones or blocks (id. col. 2, line 42+), therefore, the frame engaging parts 14-21 are inherently deformable to adjust the positions of the bolts 22-25. Further, the handlebar support members 11-13 are attached to the frame by the bolts 22-25 and washers 43-46, 34-37. Therefore, when the positions of the bolts 22-25 and

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washers 43-46, 34-37 are adjusted, the positions of the handlebar support member 11-13 are adjusted therewith. In other words, the frame engaging parts 14-21 are capable of maintaining the handlebar support members 11-13 at selectable positions. It is well settled that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then, it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Put in another fashion, the functional limitations recited in applicant's claims are not patentably distinguishing since those limitations are inherent in Henricksen reference. See *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997)(A reference may be from an entirely different field of endeavor than that of the claimed invention or may be directed to an entirely different problem from the one addressed by the inventor, yet the reference will still anticipate if it explicitly or inherently discloses every limitation recited in the claims). On the other hand, it has long been held that an element is "adapted to" perform or "capable of" performing a function is not a positive limitation but only requires the ability to so perform, thus, it does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138 (CCPA 1946).

Regarding Claim 2, at least one of said means to selectively maintain said handlebar support member 11-13 comprises, two or more bolts 22-25 that are each adapted to pass through bolt bores 28 and unnumbered (FIG. 3, Att. 1) provided in said handlebar support member 11-13 and said frame member 26.

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Regarding Claim 5, said handlebar support members 11-13 have a perimeter which remains within said perimeter of said frame member 26 wherein said handlebar support members 11-13 are capable of being positioned at any one or more of said selectable positions.

Regarding Claim 6, see one or more position indicators 34-37. Note that the washers 34-37 are capable of being used to indicate the positions of handlebar support members 11-13 as shown in FIG. 1. Therefore, the washers 34-37 "read on" the claimed position indicators.

Regarding Claim 7, Henricksen teaches a triple clamp adapted for use with a vehicle having a steering stem (not shown), one or more fork members (not shown), and one or more handlebars 10, comprising,

a frame member 26, comprising, one or more fork member bores 32, 33 adapted to receive said fork member,

one or more steering stem bores 27 adapted to receive said steering stem;

one or more handlebar support members 11-13 adapted to support said handlebar 10; and

one or more means 22-25, to selectively maintain said handlebar support member 11-13 in one or more of said selectable positions, comprising, two or more bolts 22-25 each adapted to pass through bolt bores 28 (FIG. 3, Att. 1) provided in said handlebar support member 11-13 and said frame member 26;

wherein said frame member 26 has one or more frame engaging parts 14-21 adapted to engage, at selectable positions, one or more handlebar support engaging parts 43-46 provided on said handlebar support member 11-13.

Regarding Claim 9, see regarding Claim 6 above.

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14. Claim 10 and Claims 11-14, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Song et al. (US Patent No. 6,976,691 B1 filed on December 1, 2003).

Regarding Claim 10, Song teaches a triple clamp 32 adapted for use with a vehicle 10 having a steering stem 46 (FIG. 3), steering stem angle (FIG. 2), and one or more fork members 40, comprising,

a frame member 32 comprising,

one or more fork member bores 57 adapted to receive said fork member 32,

one or more steering stem bores 56, 82 (id. col. 4, line 45+, FIGS. 4-9) adapted to receive said steering stem 46; and one or more means 44 to selectively change said angle of said steering stem 40.

Note that the positions of the stem nut 44 are adjustable within the recess 56, 82 since there is a lost motion between the nut 44 and the recess 56, 82 due to the fact that the stem nut 44 is smaller than the recess 56, 82 as seen in, e.g., FIG. 5. Hence, the stem nut 44 "reads on" the means to selective change the angle of the stem 40. *In re Casey*, *In re Otto*, *In re Schreiber*, and *In re Hutchison, supra*.

Regarding Claim 11, one or more of said means 44 to selectively change said angle of said steering stem 46 comprises, a steering angle member 44 (FIG. 4), having an offset bore (unnumbered, see FIG. 3 of Att. 2) through said inset member 44 adapted to receive said steering stem 46, that is adapted to be removably fixed in said steering stem bore 56, 82.

Regarding Claim 12, said steering angle member 44 is adapted to provide two or more selectable steering stem angles. See *In re Hutchison, supra*.

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Regarding Claim 13, said steering angle member 44 is adapted to be removably inset in said steering stem 46.

Regarding Claim 14, said frame member 32 has an outer surface and wherein said steering angle member 44 has an outer surface that, while the steering angle member 44 is inset in said steering stem bore 56, 82, is within said steering stem bore 56, 82 *below* said outer surface of said frame member 26. See FIG. 5.

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. Claims 15 and 16, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Song in view of Henricksen.

Regarding Claim 15, Song teaches one or more handlebars and one of more handlebar support members adapted to support said handlebar as shown in FIG. 2. However, Song does not teach one or more means to selectively maintain the handlebar support member in one or more selectable positions.

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Henricksen teaches one or more means 22-25 in order to selectively maintain the handlebar support member 11-13 in one or more selectable positions.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute Song's handlebar support member by Henricksen's handlebar support member with means to selectively maintain the handlebar support member in order to achieve predictable results, such as, one or more selectable positions as taught or suggested by Henricksen. *KSR International Co. v. Teleflex, Inc.* U.S., No. 04-1350, 4/30/07.

Regarding Claim 16, Song does not teach one or more means to selectively maintain the handlebar support member in one or more selectable positions comprising frame engaging parts and handlebar support engaging parts.

Henricksen teaches the frame engaging parts 14-21 and handlebar support engaging parts 43-46 in order to selectively maintain the handlebar support member 11-13 in one or more selectable positions.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute Song's handlebar support member by Henricksen's handlebar support member with frame engaging parts and handlebar support engaging parts in order to have predictable results, such as, one or more selectable positions as taught or suggested by Henricksen.

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Truchinski (FIG. 4), Durham (FIG. 2), and VanDeMortel (FIG. 3).

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19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

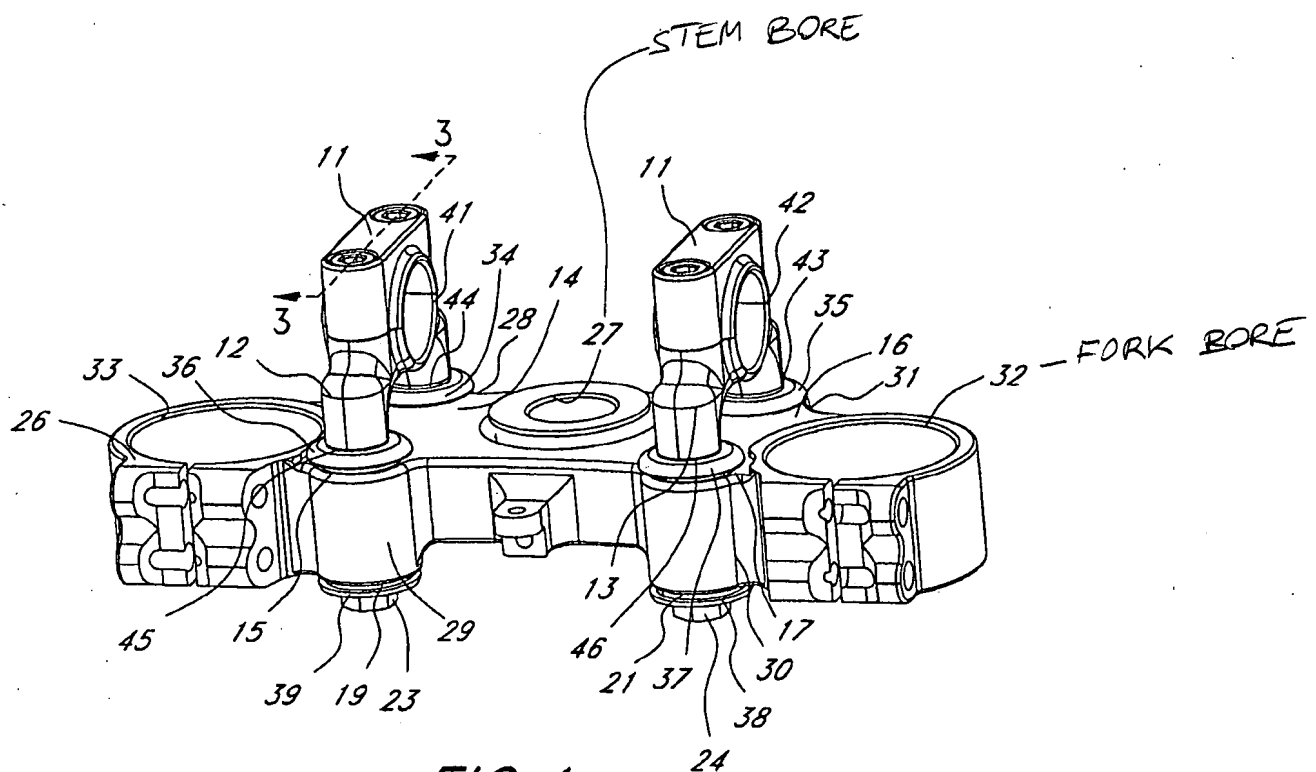
Luong

August 1, 2007



Vinh T. Luong
Primary Examiner

ATTACHMENT 1



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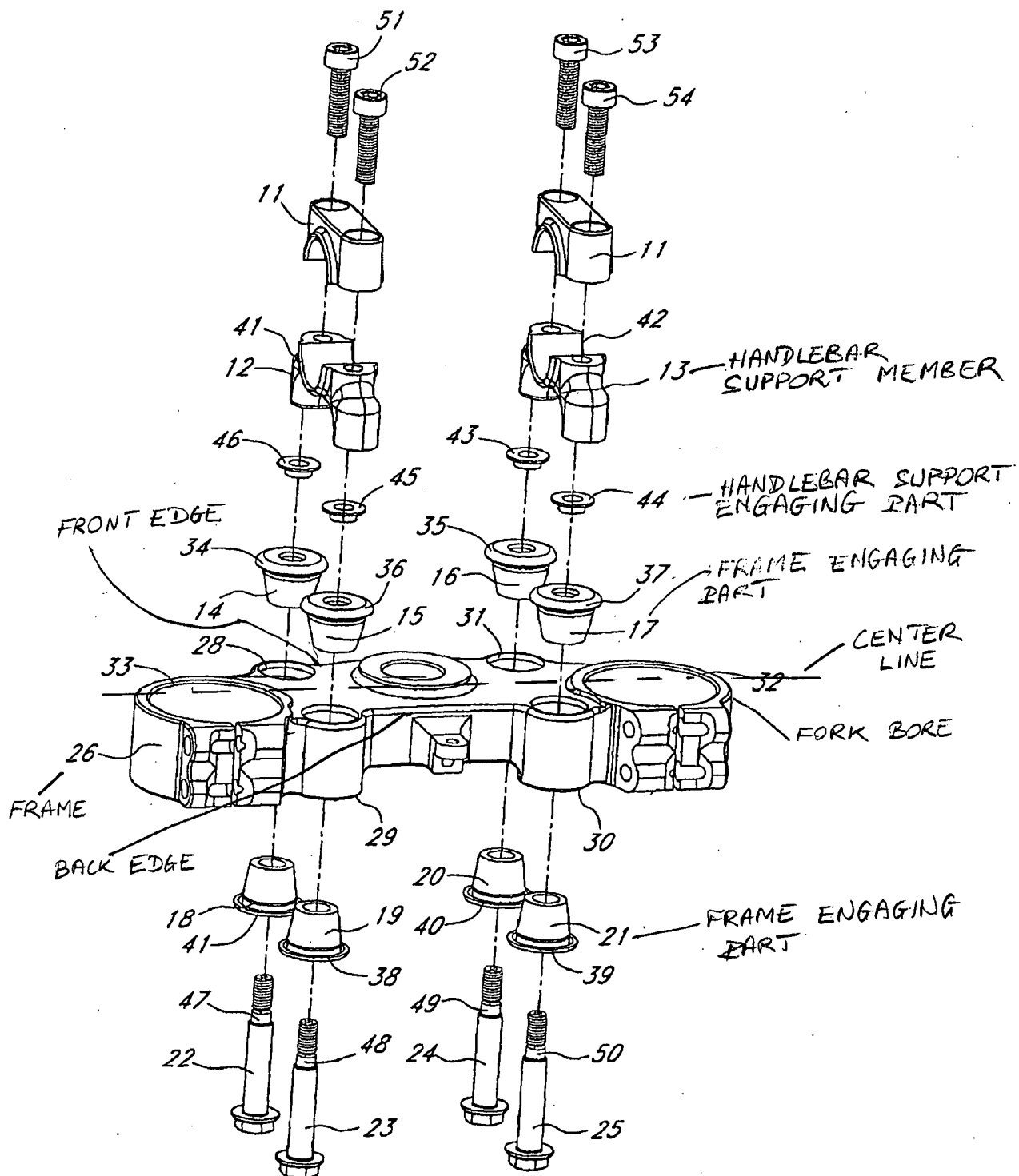
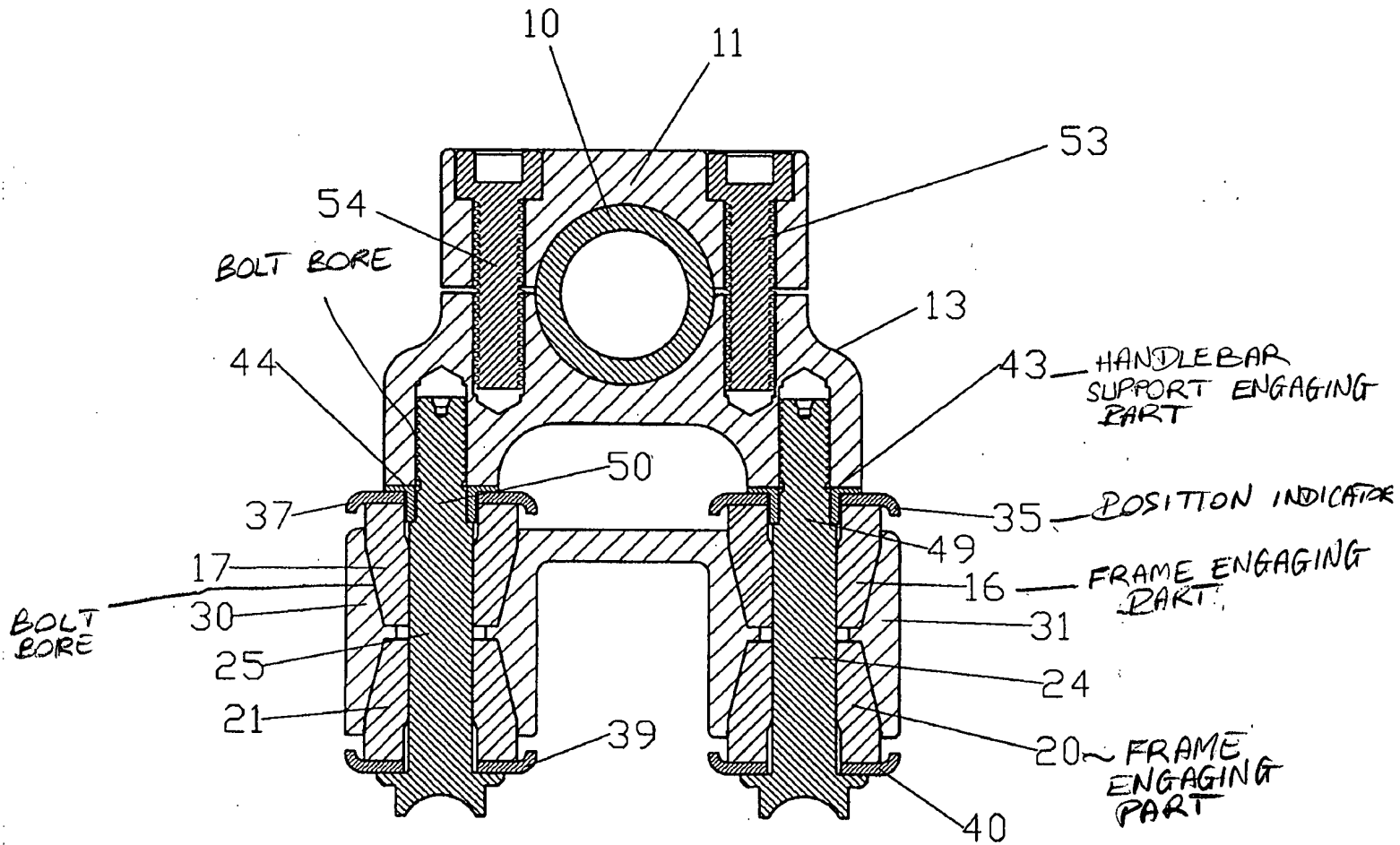


FIG. 2

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ATTACHMENT 2

